



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 608.0023USU	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>October 27, 2005</u></p> <p>Signature <u>Joanne A. Romaniello</u></p> <p>Typed or printed name <u>Joanne A. Romaniello</u></p>		Application Number <u>10/601,325</u>	Filed <u>June 20, 2003</u>
		First Named Inventor <u>Muller, et al.</u>	
		Art Unit <u>3677</u>	Examiner <u>James R. Brittain</u>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. <u>28,468</u> Registration number</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of _____ forms are submitted.</p>			

Charles N.J. Ruggiero
Signature

Charles N.J. Ruggiero

Typed or printed name

203 327 4500

Telephone number

October 27, 2005

Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s): Müller et al.

Serial No.: 10/601,325

For: HOLDING CLIP FOR FIXING THE POSITION OF
GETTERS

Filed: June 20, 2003

Examiner: James R. Brittain

Art Unit: 3677

Confirmation No.: 6977

Customer No.: 27,623

Attorney Docket No.: 608.0023USU

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

In response to the final Office Action dated June 30, 2005 and the Advisory Action dated September 15, 2005, the period for response having been extended one month up to and including October 31, 2005, Appellants respectfully file herewith a Notice of Appeal and request review of the present application before filing an appeal brief.

Related Appeals

None

Status of the Claims

Upon entry of the Amendment dated August 30, 2005, claims 1 through 7 and 11 through 13 are pending in the present application. Claims 9 and 10 are withdrawn but remain pending for rejoinder upon allowance of generic claim 1.

Claim 1 is independent. Claims 2 through 7 and 8 through 13 depend from claim 1.

Independent claim 1 stands finally rejected under 35 U.S.C. §103(a) over U.S. Patent No. 2,575,835 to Pohle (Pohle) in view of U.S. Patent No. 4,374,344 to Misono et al. (Misono).

Clear Errors for Review

Appellants respectfully submit that the Final Office Action failed to meet the three required criteria for establishing a prima facie case of obviousness, each of which is a clear error requiring review.

All Claim Elements Not Disclosed or Suggested

Independent claim 1 requires "said flexurally rigid connection and said first and second sections are elastically deformable to brace the getter in said first section and said second section in said inner surface". Thus, claim 1 recites three elastically deformable members, namely the flexurally rigid connection, the first section, and the second section.

This simple combination of three members that are elastically deformable to brace the getter in the first section and to brace the second section in the inner surface.

Pohle discloses a gettering loop 19 secured to the outer end of finger 26 or

secured to the skirt portion 25. See col. 2, lines 14-41. Similarly, Misono discloses a conductive spacer 7 that has one end secured to an electron gun structure 6 and the other end in contact with a conductive film 4. See col. 1, lines 40-43.

Thus, Pohle and Misono disclose securing, but do not disclose or suggest the simple combination of three members that are elastically deformable to brace as required by claim 1.

No Motivation to Combine

The Office Action acknowledges that Pohle does not disclose a flexurally rigid connection, but asserts that Misono discloses the claimed flexurally rigid connection. The Office Action asserts that:

“As it would be beneficial to better control the deformation of the holding clip of Pohle, it would have been obvious to modify the holding clip of Pohle so as to have a flexurally rigid connection as taught by Misono”. See the Final Office Action at page 3, lines 2-10.

Further, the Office Action reminded the Applicants that:

“In considering the disclosure of a reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably expect to draw therefrom.” Id.

Thus, the Office Action asserts that the nature of the problem itself is the source of the motivation to combine the flexurally rigid connection of Misono with the spring legs of Pohle.

In *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004), the court found motivation to combine the references to arrive at the claimed invention in the "nature of the problem to be solved" because each reference was directed "to precisely the same problem of underpinning slumping foundations." *Id.* at 1276, 69 USPQ2d at 1690.

In the instant Application, the cited references are directed to different problems. Further, the problems resolved by Pohle and Misono are both unrelated to controlling deformation as inferred by the Office Action.

As such, inferring the nature of the problem of controlling deformation from Pohle and Misono is clearly flawed and, thus, there is simply no motivation to combine the prior art in the manner suggested by the Office Action.

No Reasonable Expectation of Success

Pohle and Misono teach away from the claimed invention by securing and, not, bracing as claimed. It is submitted that that securing as disclosed by Pohle and Misono removes the need for the three members that are elastically deformable to brace as required by claim 1 and, thus, teaches away from the claimed invention. It is therefore submitted that there can be no reasonable expectation of success that the secured devices of Pohle and Misono could be combined to provide the three members that are elastically deformable to brace as required by claim 1.

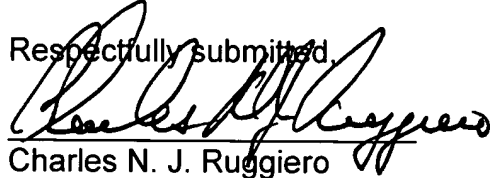
Summary

In view of the above, it is respectfully submitted that the final rejection is clearly erroneous and, as such, the present application is in condition for allowance. Reconsideration and withdrawal of the rejection to claim 1, as well as claims 2 through 7 and 11 through 13 that depend therefrom, and passage of the present application to issuance are respectfully requested. In addition, rejoinder and allowance of withdrawn claims 9 and 10 are also respectfully requested since generic claim 1 is in condition for allowance. Such actions are respectfully solicited.

If for any reason the Examiner feels that consultation with Appellants' attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the telephone number below.

October 27, 2005

Respectfully submitted,



Charles N. J. Ruggiero

Reg. No. 28,468

Attorney for Appellant(s)

Ohlandt, Greeley, Ruggiero & Perle, L.L.P.

One Landmark Square, 10th floor

Stamford, CT 06901-2682

Tel: (203) 327-4500

Fax: (203) 327-6401